

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference	FOR FURTHER ACTION	See item 4 below
International application No. PCT/US2004/019418	International filing date (<i>day/month/year</i>) 18 June 2004 (18.06.2004)	Priority date (<i>day/month/year</i>) 19 June 2003 (19.06.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant NEURONETRIX, INC.		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | |
|---|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report |
| <input checked="" type="checkbox"/> Box No. II | Priority |
| <input type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI | Certain documents cited |
| <input checked="" type="checkbox"/> Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 740 14 35	Date of issuance of this report 19 December 2005 (19.12.2005)
	Authorized officer Simin Baharlou Telephone No. +41 22 338 71 30

PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY
(PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/US2004/019418

International filing date (day/month/year)
18.06.2004

Priority date (day/month/year)
19.06.2003

International Patent Classification (IPC) or both national classification and IPC
A61B5/0484

Applicant
NEURONETRIX, INC.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1b(s)(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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Authorized Officer

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Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ In written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

Box No. II Priority

1. ☒ The following document has not been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	4-22,24-32
	No: Claims	1-3,23
Inventive step (IS)	Yes: Claims	11
	No: Claims	1-10,12-32
Industrial applicability (IA)	Yes: Claims	1-32
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Re Item V.

V.1 The following documents are referred to in this communication:

- D1 : US 5 954 667 A (FINKENZELLER PETER ET AL) 21 September 1999 (1999-09-21)
- D2 : EP 1 238 629 A (MAICO DIAGNOSTIC GMBH) 11 September 2002 (2002-09-11)
- D3 : US 5 755 230 A (BUCKETT JAMES R ET AL) 26 May 1998 (1998-05-26)
- D4 : WO 00/66209 A (GENGER HARALD ; MAP GMBH (DE); NEGELE CLAUS (DE)) 9 November 2000 (2000-11-09)

V.2 DEVICE CLAIMS 1-3

The document D1 is regarded as being the closest prior art to the subject-matter of independent device claims 1-3, and discloses (the references in parentheses applying to this document) a screening device comprising a frame (10) with a reference electrode (22) and signal electrodes (21), an auditory signal producer (40), a AER Data processor (40), flexible arm (12).

thus, D1 specifies all the features of claims 1-3 of the present application. Therefore the present application does not meet the requirement of Article 33(2) PCT because the subject-matter of claims 1-3 is not novel.

V.3 INDEPENDENT METHOD CLAIM 23

For the same reason as in V.2, the subject matter of said claim 23 is not novel (Article 33(2) PCT).

V.4 DEPENDENT CLAIMS 4-10, 12-22, 24-32

Dependent claims 4-10, 12-22, 24-32 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of inventive step (Article 33(3) PCT) because subject matters of said claims relate more to constructional details and signal processing details without surprising effect.

Dependent claim 20 does not contain any features which, in combination with the features of any claim to which it refers meet the requirements of the PCT in respect of inventive step (Article 33(3) PCT) because subject matters of said claim is anticipated by a combination of disclosures D1 and D2.

V.5 DEPENDENT CLAIM 11

The combination of the features of dependent claim 11 appears to be neither known from, nor rendered obvious by, the available prior art so that subject matters of said claim might acknowledge prima facie an inventive ingenuity.

Re Item VII.

The attention of the applicant is drawn to the fact that the application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

Reference signs of the drawings should be mentioned in the claims to these features.

Documents **D1 should be identified** in the description and the relevant background art disclosed therein should be briefly discussed.

Independent claims are not in the **two-part form**, which in the present case would be appropriate, with those features known in combination from the prior art (document D1) being placed in the preamble and with the remaining features being included in the characterising part.

The dependant claims should be drafted having regard to the new independent claim.